

REMARKS

The office action dated January 16, 2007 (the "Office Action") has been received and noted. Claims 1-7 were examined. Claims 1-7 were rejected. Claim 1 is amended. Support for the amendment can be found in, for example, Paragraph [0018] of the Application. As such, no new matter has been added. Claims 1-7 remain in the application. Reconsideration of the pending claims is requested in view of the above-amendments and following remarks.

I. Amendments to Drawings

Applicants hereby submit a replacement drawing to correct a numerical reference error in Figure 2. Specifically, **electrically conductive cable 230** connecting counter electrode 208 to counter electrode terminal 228 was erroneously labeled as numerical reference "226". The replacement drawing corrects this error and properly refers to electrically conductive cable 230 as numerical reference "230". Support for the amendment can be found in, for example, Paragraph [0018] of the Application. As such, no new matter has been added. Applicant respectfully requests entry of the replacement drawing for Figure 2.

II. Claims Rejected Under 35 U.S.C. § 102

A. Claims Rejected as Anticipated by Gealer

Claims 1-7 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,765,865 to Gealer et al. ("*Gealer*"). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP § 2131. Applicant respectfully submits that each and every element, either expressly or inherently, in amended independent claim 1 and its respective dependent claims is not set forth in the cited reference.

Amended claim 1 includes the limitation of "a potentiostat having a counter electrode terminal to couple to a counter electrode, a reference electrode terminal to couple to a reference electrode, and a working electrode terminal to couple to . . . the substrate *by an independent clip*." (App., claim 1). Representatively, conductive cable 224 is shown connected to wafer 220 by clip 226 in Figure 2 of the Application. (App., FIG. 2). The significance of clip 226 is

illustrated in the Application, which states in pertinent part, “[c]lip 226 makes good electrical contact with the conductive layer to be selectively etched off wafer 220.” (App, ¶ [0018]). By contrast, *Gaeler* discloses a system to increase the etch rate of a wafer including reaction vessel 13, reference electrode 23 and **holder 11 which simultaneously holds wafer/fragment 9 and platinum gauze counter-electrode 10.** (col. 5, lns. 20-43; FIG. 2). Thus, *Gaeler* does not disclose each and every limitation of independent claim 1. Dependent claims 2-7 depend on independent claim 1 and therefore include all of its limitations. Accordingly, Applicants submit that independent claim 1 and its respective dependent claims are allowable over the cited reference.

B. Claims Rejected as Anticipated by *Nojiri*

Claims 1-7 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 58,173,149 to Nojiri et al. (“*Nojiri*”). Applicant respectfully submits that each and every element, either expressly or inherently, in amended independent claim 1 and its respective dependent claims is not set forth in the cited reference. Amended claim 1 includes the limitation of “a potentiostat having a counter electrode terminal to couple to a counter electrode, a reference electrode terminal to couple to a reference electrode, and a working electrode terminal to couple to **a portion of the conductive layer to be selectively removed of the substrate by an independent clip.**” (App., claim 1). Representatively, conductive cable 224 is shown connected to wafer 220 by clip 226 in Figure 2 of the Application. (App., FIG. 2). The significance of clip 226 is illustrated in the Application, which states in pertinent part, “[c]lip 226 makes good electrical contact with the conductive layer to be selectively etched off wafer 220.” (App, ¶ [0018]). By contrast, *Nojiri* discloses an electrolytic etching apparatus including electrolytic bath 1, reference electrode 22, opposing electrode 4 and a lead connected to metallic film 31 of substrate 3. (col. 6, lns. 14-51; FIG. 5). According to *Nojiri*, the portion of substrate 3 to be etched is p-type substrate 3a, which **is not** in direct connection with the lead connecting to substrate 3 (again, the lead is connected to metallic film 31). (FIG. 5). The Examiner has not relied upon and Applicants have been unable to discern any part of *Nojiri* that discloses “**a portion of the conductive layer to be selectively removed of the substrate by an independent clip**” as recited in claim 1. Thus, *Nojiri* does not disclose each and every limitation of independent claim 1. Dependent claims 2-7 depend on independent claim 1 and therefore include all of its limitations. Accordingly, Applicants

submit that independent claim 1 and its respective dependent claims are allowable over the cited reference.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-7 and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 500-4787.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: March 15, 2007



Shelley M. Cobos Reg. No. 56,174

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
Telephone (310) 207-3800
Facsimile (310) 820-5988

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on March 15, 2007.

Si Vuong

